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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,740	04/14/2004	James J. Robinson	033679-532	4901

21839 7590 08/25/2005

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EXAMINER

ADDISU, SARA

ART UNIT PAPER NUMBER

3722

DATE MAILED: 08/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/823,740

Applicant(s)

ROBINSON ET AL.

Examiner

Sara Addisu

Art Unit

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 21-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Arguments***

The indicated allowability of claims 21, 22 and 26 are withdrawn in view of the newly discovered reference(s) to Kelly et al. (U.S. Patent No. 2,503,951) and Hunter (U.S. Patent No. 867,275). Rejections based on the newly cited reference(s) follow.

### ***Specification***

2. The abstract of the disclosure is objected to because it is in claim format and contains legal phraseology, e.g. "comprising" Correction is required. See MPEP § 608.01(b).

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 23 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear how the leaf bending element comprises at least one tapered screw. It appears that the leaf bending element has a tapered portion engaging a tapered portion of the screw head. For the purpose of this Office Action, the phrase "isolating channel straddling the threaded hole" is interpreted as a screw hole wherein the channel is on diametrically opposing sides. The isolating channel is not technically straddling anything as straddling is defined as "to sit or stand so that one leg is on one side and the other leg is on the other side of something".

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

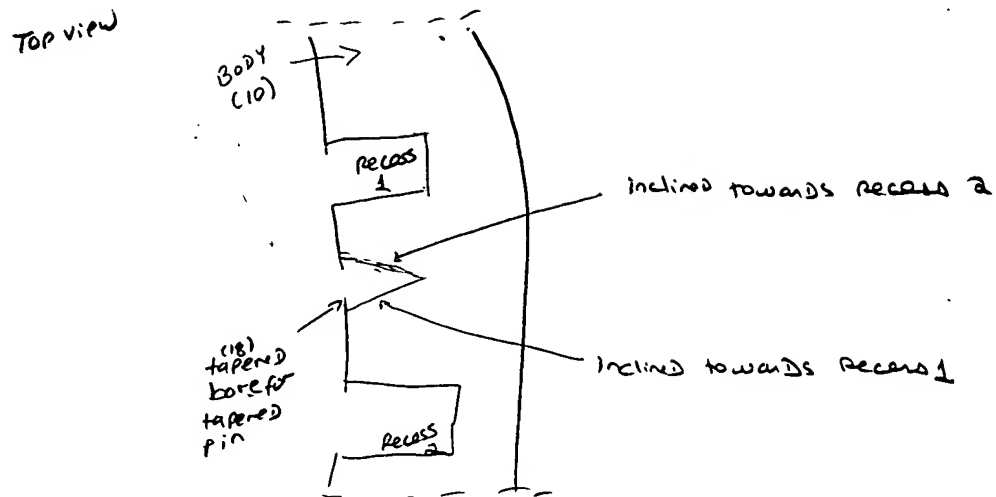
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 21, 22 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Kelly et al. (U.S. Patent No. 2,503,951).

Kelly et al. teaches in Figure 5, a tool body (23) for a rotatable cutting tool having at least one recess (24) with a first and second opposing walls for releasably retaining a replaceable insert (25 with exposed cutting edge), an isolating channel/slot (17) spaced from the recess to define an elastically deformable leaf there between, wherein the first wall of the recess is formed by the leaf. Kelly et al. also teaches a tapered pin (leaf bending element) (19) adjustable within the isolating channel for elastically bending the leaf from a relaxed position to a clamping position wherein the first wall clamps the insert against the second wall. Furthermore, Kelly et al. teaches in Figure 5, first wall that is inclined at a shallow angle relative to the second wall and when the leaf is in the relaxed position, the first wall diverges from the second wall in a direction away from an open end of the recess (('951, Col. 3, lines 45-56). Kelly et al also teaches tapered bore (18) which is part of the isolation channel (17) therefore each side of the taper is inclined at a shallow angle towards a recess of the opposite side, in a direction away from an open end (in a direction looking into the page of figure 1) of the isolation channel (see below).

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### **Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 23, 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kelly et al. (U.S. Patent No. 2,503,951), in view of Hunter (U.S. Patent No. 867,275).

Kelly et al. teaches a rotatable cutting tool as set forth in the above rejection. Furthermore, Kelly et al. teaches a tapered pin (leaf bending element) (19) adjustable within the chamfered/tapered bore (18) of the isolating channel (i.e. the channel is on diametrically opposing sides of the pin/tapered bore as shown in figure 5) for elastically bending the leaf from a relaxed position to a clamping position wherein the first wall clamps the insert against the second wall. It is clear from figure 1 and 5, that the diameter of the pin head (19) is larger than a width of the isolating channel.

However, Kelly et al. fails to teach the leaf bending element being a screw that engages a threaded hole in the tool.

Hunter teaches a tool body (2) for a rotatable cutting tool having at least one tooth socket/recess (3) with a first and second opposing walls for releasably retaining a replaceable cutter/insert (7 with exposed cutting edge), an isolating channel (14) spaced from the recess to define an elastically deformable leaf there between, wherein the first wall of the recess is formed by the leaf. Hunter also teaches taper headed screw (15) engaging a threaded hole in the tool body as well as chamfer at the open end of the channel (14) (see figures 1, 3 and 6). Regarding claim 25, hunter teaches in figure 4, tapered isolation channel (14) (i.e. inclined at a shallow angle) that causes the base of the leaf to be narrower than that it's portion near the top (near the open end).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Kelly et al.'s invention such that the tapered pin is replaced by a taper headed screws and is received within a chamfered slot as taught by Hunter for the purpose of having a positive engagement between the screw and the tool body (the pin may have the tendency to pop out).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sara Addisu at (571) 272-6082. The examiner can normally be reached on 8:30 am - 5 PM.

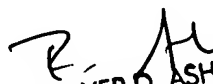
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley can be reached on (571) 272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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SA  
6/22/05

  
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PRIMARY EXAMINER